

REMARKS

This Response is submitted in reply to the Office Action dated December 17, 2003. Claims 1, 23 and 47 have been amended. No new matter has been added in these amendments. A Terminal Disclaimer is submitted herewith. A Petition for a Two-Month Extension of Time to respond to the Office Action is submitted herewith. A Supplemental Information Disclosure is submitted herewith. A check in the amount of \$710.00 is submitted herewith to cover the cost of the Terminal Disclaimer, the two-month extension of time and the Supplemental Information Disclosure Statement. Please charge Deposit Account No. 02-1818 for any insufficiency of payment.

The Office Action rejected Claims 1, 2, 12, 13, 23 and 24 under the non-statutory, judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 3, 7, 10, 11 and 13 of U.S. Patent No. 6,602,136. Applicants are hereby submitting a Terminal Disclaimer to overcome this rejection.

Claims 1 to 25 and 47 to 49 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Office Action states that Claims 1, 23, 47 are claimed as gaming apparatuses, however the claim language is also directed to methods of operating a claim. Applicants respectfully disagree with these rejections. However, Applicants have amended these claims for clarity and not to distinguish these claims over the prior art.

The Office Action rejected Claims 1 to 9, 13, 14, 23, 24, 26, 27, 31, 34 and 37 to 49 under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,517,432 to Jaffe ("Jaffe"). Applicants respectfully submit that Jaffe is not prior art of the present invention. Applicants hereby submit, under 37 C.F.R. 1.131, an Affidavit of Anthony J. Baerlocher, a named inventor of the present invention. This Affidavit establishes that prior to the effective date of Jaffe, March 21, 2000, the Applicants conceived and reduced to practice the claimed invention. The Affidavit of Mr. Baerlocher establishes that the claimed invention was conceived at least as early as December 23, 1998. This Affidavit also establishes that the claimed invention was reduced to practice at least as early as December 15, 1999. Exhibit A, which is attached to the Affidavit of Anthony J.

Baerlocher, is an IGT Project Report for the commercial embodiment of the game incorporating the claimed invention. This Project Report establishes the date of invention is at least as early as December 23, 1998. Exhibit A specifically states in an entry made on December 23, 1998, "Please develop a new five line vision slot game called 'Fox 'n' Hound.... The bonus feature will be a chase game between the fox and the hound. Both characters will start on the looping track with the fox getting a head start. They will alternate moving with the fox going first via a reel or some other device to move them a random number of locations along the track. Wherever the fox lands a prize will be added to the win meter. The chase continues until either the fox catches the hound, in which case a bonus will occur; or the hound catches the fox." Page 2 of Exhibit A evidences that the claimed invention was reduced to practice at least as early as December 15, 1999. Exhibit A evidences that a gaming device implementing the commercial embodiment of the present invention was submitted to the Nevada Gaming Control Board on December 15, 1999 and approved by the Nevada Gaming Control Board on January 12, 2000. Accordingly, Applicants respectfully submit that Jaffe is not prior art of the present invention under 35 U.S.C. §102(e) and Claims 1 to 9, 13, 14, 23, 24, 26, 27, 31, 34 and 37 to 49 are in condition for allowance.

The Office Action rejected Claims 10 to 12, 15 to 22, 28 to 30, 32, 33, 35 and 36 under 35 U.S.C. 103(a) as being unpatentable over Jaffe in view of U.S. Patent No. 6,520,855 to DeMar ("DeMar"). However, as previously discussed, Applicants respectfully submit that Jaffe is not prior art of the present invention.

DeMar is directed to a plurality of bonus games which all include a game board (Monopoly) with a plurality of stations or properties that are each associated with an award. In one embodiment, a player selects a player symbol, and the game moves the player symbol to one or more stations. The game provides the player any award associated with each visited station. In another embodiment, one of the stations of the game board is designated a bonus station and a payoff is awarded to the player each successive time a player symbol reaches the bonus station (e.g., each time the player passes GO). The payoff escalates each successive time the player symbol reaches the bonus station. In another embodiment, a player selects a predicted position on the

game board (e.g., buys a house for a property), the game determines a true position (e.g., moves a player symbol to a property) and provides an award if the predicted position matches the true position (e.g., the player symbol lands on the property with the house). DeMar does not teach, disclose or suggest a gaming device including at least one terminating symbol and a processor which is operable to cause the terminating symbol to visit at least one of the locations on the path.

Dependent Claims 10 to 12, and 15 to 22 (depending directly or indirectly from independent Claim 1) all include, in combination with other elements, at least one terminating symbol and a processor operable to cause the terminating symbol to visit at least one of the locations on the path. DeMar does not teach disclose or suggest a terminating symbol or a processor operable to cause the terminating symbol to visit at least one of the locations on the path. For this reason, Applicants respectfully submit that Claims 10 to 12, and 15 to 22 are patentably distinguished over DeMar and are in condition for allowance.

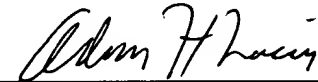
Dependent Claims 28 to 30, 32, 33, 35 and 36 (depending directly or indirectly from independent Claim 26) all include, in combination with other elements, displaying a path which includes a plurality of locations and causing at least one player symbol to visit one of the plurality of locations. These claims include causing at least one terminating symbol to visit one of the plurality of locations and repeating these steps until the player symbol catches the terminating symbol or the terminating symbol catches the player symbol. DeMar does not teach, disclose or suggest a terminator symbol. Moreover, DeMar does not teach, disclose or suggest causing at least one terminating symbol to visit locations until the player symbol catches the terminating symbol or the terminating symbol catches the player symbol. For these reasons, Applicants respectfully submit that Claims 28 to 30, 32, 33, 35 and 36 are patentably distinguished over DeMar and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

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BY



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